

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
(Case No. 05-1082)

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|--|---|---------------------------|
| In the Application of:                   | ) |                           |
|  | ) |                           |
| Lutz Wolfgang Gruneberg et al.           | ) | Examiner: Karikari, Kwasi |
|  | ) |                           |
| Serial No. 10/565,955                    | ) | Group Art Unit: 2617      |
|  | ) |                           |
| Filed: January 26, 2006                  | ) | Confirmation No. 8456     |
|  | ) |                           |
| For: A Method and System to Enable Email | ) | Customer No. 20306        |
| Services for Mobile Devices              | ) |                           |

**PRE-APPEAL BRIEF REQUEST FOR REVIEW ACCOMPANYING**  
**NOTICE OF APPEAL**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

S I R:

**ERRORS IN THE PRIOR REJECTION**

Consistent with the Review Requirements for identification of clear errors, Applicants note the following clear errors set forth in the December 11, 2009 Final Office Action:

1. The Examiner failed to assert a *prima facie* case of obviousness of claims 1, 4-10, and 13-19 in view of the Stoifo and O'Rourke references
2. The Examiner failed to assert a *prima facie* case of obviousness of claims 2-3 and 11-12 in view of the Stoifo, O'Rourke, and AAPA references

**REMARKS**

**A. The §103 Rejection of Claims 1, 4-10, and 13-19 Is Clearly Erroneous**

Applicants respectfully request review of the Examiner's rejection of claims 1, 4-10, and 13-19 under 35 U.S.C. §103(a). The Examiner rejected these claims over the cited references of Stoifo (US Pat. Pub. No. 2001-0034709) in view of O'Rourke (United States Patent No. 7,173,933). As

set forth on page 3, four lines from the bottom-page 5, three lines from the top, the Examiner relied upon the O'Rourke reference solely for the limitation "sending email from and receiving email by the terminal" appearing in the preamble of independent claim 1 and similar limitations of independent claims 7, 8, and 10. The Examiner exclusively relied upon the Stoifo reference for disclosing and/or teaching the remaining limitations of the claims.

Applicants respectfully submit that the Examiner's reliance upon the Stoifo reference for its purported disclosure of an "email proxy [] configured to detect a unique network address of the terminal and retrieve email configuration settings from the database using the unique network address of the terminal and...to communicate with an email server using the retrieved email configuration settings" amounts to clear error. More specifically, the Examiner erroneously relies upon paragraphs [0004, 0012, 0021, and 0025] as disclosing this claim limitation. Moreover, the Examiner erroneously asserts that "the proxy identification" disclosed in these paragraphs is equivalent to the claimed "email configuration settings."

As set forth in paragraph [0021] of Stoifo, the proxy identifications stored in identity bank 109 of Stoifo are "generated by a random identification generator" and are each assigned to a particular "true user identification." A message received from a user computer 101 coded in "a browser language such as hypertext markup language (HTML)" or "extensible markup language (XML) or other browser language" then has its true user identification replaced with the randomly generated proxy identification from the identity bank. (See paragraph [0011]). Subsequently, the "portal server 107 forwards the message to Web server 103 using the proxy identification." (See paragraph [0012]).

Clearly, Stoifo's disclosure of modifying web-page requests to include randomly-generated user proxy identifications is not equivalent to the claimed "email proxy [] configured to detect a unique network address of the terminal and retrieve email configuration settings from the database using the unique network address of the terminal and...to communicate with an email server using the retrieved email configuration settings." For at least this reason, Applicants submit that the Examiner's rejection of claims 1, 7, 8, and 10 is clearly erroneous and should be withdrawn.

Particularly regarding independent claims 7 and 8, Applicants submit that Stoifo fails to disclose or suggest modification of an e-mail request using the retrieved email configuration settings. As set forth above, Stoifo discloses and/or suggest only the modification of outgoing web-based messages by the proxy identification retrieved from the identity bank.

Particularly regarding claims 16-19, Applicants submit that the Examiner has failed to meet the burden of establishing a prima facie case of obviousness for at least the reason that the general citation of paragraphs [0004, 0012, and 0021] does not amount to the "articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" required by MPEP § 2142, nor does it meet the specificity standards set forth in 35 U.S.C. § 132, 37 C.F.R. § 1.104, and M.P.E.P. § 706. A PTO patent application claim rejection violates Section 132 if it "is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection." *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990). In this case, the Examiner has failed to particularly point out where each limitation of dependent claims 16-19 can be found in the cited art of record. Applicants can only respond by pointing out that paragraphs [0004, 0012, and 0021] of Stoifo do not disclose any of the limitations of claims 16-19. More specifically, the cited paragraphs fail to disclose "responsive to receiving an email request from the terminal containing default values not associated with a user of the terminal," and fails to disclose "replace the default

values with values associated with the user of the terminal from the retrieved email configuration settings prior to communicating with the email server using the retrieved email configuration settings.” Rather, and at most, the cited paragraphs of Stoifo disclose an anonymizing portal server 10 that receives a web request containing particular user information, replaces the particular user information with randomized proxy user information not associated with the user of the user computer 101, and communicates with a web server using the modified web request. Not only does this disclosure fail to teach or suggest the additional limitations of claims 16-19, it actually teaches away from claims 16-19 by teaching the advantages of replacing particularized user information with randomized/unassociated user information.

For at least these reasons also, Applicants submit that the Examiner’s rejection of claims 16-19 is clearly erroneous and should be withdrawn.

**B. The §103(a) Prior Art Rejection of Claims 2-3 and 11-12 Is Clearly Erroneous**

Applicants respectfully request review of the Examiner’s rejection of claims 2-3 and 11-12 under 35 U.S.C. §103(a). The Examiner rejected these claims over the cited references of Stoifo in view of O’Rourke and further in view of Applicant Admitted Prior Art (AAPA).

First, Applicants respectfully submit that they contested the Examiner’s use of AAPA in combination with the Stoifo reference in the last response filed on September 11, 2009. For at least the reasons set forth in MPEP § 707.07(f), and “in order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application” and “[w]here the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment.” Applicants submit that the

Examiner's failure to acknowledge and address Applicant's prior argument itself amounts to clear error.

In any event, and as set forth by the Federal Circuit in *In re Gordon*, an obviousness rejection is improper if "the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose." *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The cited Stoifo reference is directed to replacing "true" user identification information with randomly generated non-user specific proxy identification information (See paragraphs [0021], [0022], and [0025] of Stoifo). Retrieving the claimed email configuration parameters and inserting the AAPA-disclosed parameters of a true user name, email server, and/or password in order to retrieve e-mail would render Stoifo unsatisfactory for its intended purpose. For at least this reason also, Applicants submit that the Examiner's rejection is clearly erroneous, and should be withdrawn by the panel.

Additionally, AAPA discloses direct communication of e-mail server, username, and/or password information from client to e-mail server, and fails to disclose or suggest anything regarding storage of such parameters in an email configuration database, or providing for an email proxy that can retrieve such parameters from the database and use such parameters to communicate with an email server. For at least this reason also, Applicants submit that the Examiner's rejection is clearly erroneous, and should be withdrawn by the panel.

For all the above reasons, Applicants respectfully submit that all claims are in condition for allowance over the cited art of record and respectfully request a Notice of Allowance.

Respectfully submitted,  
**McDonnell Boehnen Hulbert & Berghoff LLP**

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